

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

NETLIST, INC.,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD., et al.,

Defendants.

Civil No. 2:22-cv-00293-JRG
(Lead Case)

JURY TRIAL DEMANDED

NETLIST, INC.,

Plaintiff,

v.

MICRON TECHNOLOGY TEXAS, LLC, et al.,

Defendants.

Civil No. 2:22-cv-00294-JRG
(Member Case)

JURY TRIAL DEMANDED

**SAMSUNG'S OPPOSITION TO NETLIST'S MOTION FOR SUMMARY JUDGMENT
ON SAMSUNG'S AFFIRMATIVE DEFENSE OF CLAIM PRECLUSION (DKT. 365)**

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* In this brief, all emphasis is added unless noted otherwise

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TABLE OF EXHIBITS¹

#	Description
A	August 20, 2019, Office Action, U.S. Patent Application No. 16/391,151 (now U.S. Patent No. 10,860,506) (excerpts)
B	Terminal Disclaimer, U.S. Patent Application No. 16/391,151 (now U.S. Patent No. 10,860,506)
C	Complaint, <i>Netlist Inc. v. Samsung Elecs. Co.</i> , No. 2:21-CV-463 (E.D. Tex.) (excerpts)
D	Third Amended Complaint Against Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Semiconductor, Inc., <i>Netlist Inc. v. Samsung Elecs. Co.</i> , No. 2:22-CV-293 (E.D. Tex.) (excerpts)
E	Plaintiff Netlist Inc.'s Second Supplemental Disclosure of Asserted Claims and Infringement Contentions (excerpts)
F	Exhibit D ('608 Patent) to Opening Expert Report of Dr. William Henry Mangione-Smith (excerpts)

TABLE OF ABBREVIATIONS

Abbreviation	Description
'506 patent	United States Patent No. 10,860,506
'608 patent	United States Patent No. 10,268,608
DDR4	Double Data Rate 4
<i>EDTX1</i>	<i>Netlist Inc. v. Samsung Elecs. Co.</i> , No. 2:21-CV-463 (E.D. Tex.)
JDLA	Joint Development and License Agreement (Dkt. 273-7)
LRDIMM	Load-Reduced Dual Inline Memory Module
RDIMM	Registered Dual Inline Memory Module
SSMF	Samsung's Counter-Statement of Material Facts

¹ Citations to Exs. 1-5 refer to exhibits attached to Netlist's motion. *See* Dkt. 365-2 to 365-6.

Netlist's motion for summary judgment of no claim preclusion should be denied as contrary to the law and facts—the *EDTX1* judgment covers Netlist's infringement allegations for the '608 patent claims, which are essentially the same as the '506 patent claims asserted in *EDTX 1*.

I. RESPONSE TO NETLIST'S STATEMENT OF ISSUES

1. Is Netlist entitled to summary judgment on Samsung's claim preclusion defense?

II. RESPONSE TO NETLIST'S STATEMENT OF UNDISPUTED FACTS

2. Disputed. Netlist never moved to dismiss the '506 patent from *EDTX1* and this Court never dismissed it without prejudice. Netlist's '506 patent infringement claim remained pending when this Court entered final judgment denying "[a]ll other requests for relief." Ex. 2 at 4.

III. SAMSUNG'S COUNTERSTATEMENT OF MATERIAL FACTS

1. During prosecution of the '506 patent, the examiner issued a double patenting rejection over the '608 patent and compared the claim language to establish that the claims were patentably indistinct. Ex. A at 2-6. Netlist filed a terminal disclaimer in response. Ex. B.

2. Netlist accuses the same products (DDR4 LRDIMMs) of infringing both the '608 and '506 patents based on substantially overlapping allegations. Ex. C, ¶¶ 39-51; Ex. D, ¶¶ 69-81. Netlist has not accused Samsung's RDIMMs of infringing the '608 patent. Ex. D, ¶¶ 69-81; Ex. E; Ex. F.

IV. ARGUMENT

A. The *EDTX1* Final Judgment Gives Rise to Claim Preclusion

Netlist argues that there was no final judgment for the '506 patent, but applies the wrong law. Whether the '506 patent was dismissed is "a purely procedural question" governed by "the law of the regional circuit." *Garber v. Chicago Mercantile Exch.*, 570 F.3d 1361, 1363 (Fed. Cir. 2009). Thus, Netlist's reliance on *Sandisk* and cases applying it is erroneous. Under Fifth Circuit law, a party's "abandonment" of a claim does not dismiss it without prejudice absent a stipulation or a motion and order dismissing the claim. *G.A. Thompson & Co. v. Partridge*, 636 F.2d 945, 951-53 (5th Cir. 1981).

Nor would dismissal without prejudice have been permissible. After a defendant answers, a court may not unconditionally dismiss without prejudice if it would “cause plain legal prejudice.” *Elbaor v. Tripath Imaging, Inc.*, 279 F.3d 314, 317-18 (5th Cir. 2002). It causes “[p]lain legal prejudice” to dismiss without prejudice “at a late stage of pretrial proceedings.” *In re FEMA Trailer Formaldehyde Prods. Liab. Litig.*, 628 F.3d 157, 162-163 (5th Cir. 2010); *Harris v. Devon Energy Prod. Co.*, 500 F. App’x 267, 268 (5th Cir. 2012). Netlist chose to wait until the eve of trial to narrow its claims. Ex. 1. It chose not to move for dismissal without prejudice, thus depriving this Court of an opportunity to craft curative conditions. *Elbaor*, 279 F.3d at 317-18. Thus, final judgment encompassed Netlist’s claim for infringement of the ’506 patent. Ex. 2 at 4.

B. The *EDTX1* Final Judgment Precludes Netlist’s Assertion of the ’608 Patent

Netlist’s ’608 patent allegations do not raise a new claim. “[A] claim is defined by the transactional facts from which it arises,” based on whether the facts “are related in time, space, origin, or motivation, [and] whether they form a convenient trial unit.” *Acumed LLC v. Stryker Corp.*, 525 F.3d 1319, 1323-24 (Fed. Cir. 2008); *Houston Prof’l Towing Ass’n v. City of Houston*, 812 F.3d 443, 447 (5th Cir. 2016). No expert testimony is needed to discern that Netlist’s ’506 and ’608 patent allegations involve “the same nucleus of operative facts.” *Gillig v. Nike, Inc.*, 602 F.3d 1354, 1362-63 (Fed. Cir. 2010). The claims are “essentially the same” on their face, Netlist’s infringement allegations overlap extensively, and Netlist’s “terminal disclaimer is a strong clue” that the claims “lacked a patentable distinction.” *SimpleAir, Inc. v. Google LLC*, 884 F.3d 1160, 1167-68 (Fed. Cir. 2018); SSMF ¶¶ 1-2.

Netlist’s arguments are unavailing. Netlist argues minor differences between the claims avoid claim preclusion; but the vast majority of limitations and relevant facts are the same, as the examiner showed in his double patenting rejection. SSMF ¶ 1. Netlist’s only other argument—that “the accused products are different” because “Netlist asserts that Samsung’s DDR4 RDIMMs infringe the ’608 Patent,” Dkt. 365 at 4—is incorrect; Netlist accused only LRDIMMs for both patents. SSMF ¶ 2.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document was filed electronically in compliance with Local Rule CV-5 on January 30, 2024. As of this date, all counsel of record have consented to electronic service and are being served with a copy of this document through the Court's CM/ECF system under Local Rule CV-5(a)(3)(A) and via electronic mail.

/s/ Lauren A. Degnan

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